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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte PHILIP D. MOONEY, JOSEPH M. CANNON,
and JAMES A. JOHANSON

Appeal 2009-005182
Application 09/767,839
Technology Center 2600

Before JOSEPH F. RUGGIERO, JOSEPH L. DIXON, and
MAHSHID D. SAADAT, *Administrative Patent Judges*.

RUGGIERO, *Administrative Patent Judge*.

DECISION ON APPEAL¹

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, or for filing a request for rehearing, as recited in 37 C.F.R. § 41.52, begins to run from the “MAIL DATE” (paper delivery mode) or the “NOTIFICATION DATE” (electronic delivery mode) shown on the PTOL-90A cover letter attached to this decision.

STATEMENT OF THE CASE

Appellants appeal under 35 U.S.C. § 134 from the Final Rejection of claims 4, 5, 7-10, 13-17, 19-23, 38, 41, 42, 45, 46, and 50, which are all of the pending claims. Claims 1-3, 6, 11, 12, 18, 24-37, 39, 40, 43, 44, and 47-49 have been canceled. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

Rather than reiterate the arguments of Appellants and the Examiner, we refer to the Appeal Brief (filed May 24, 2007), the Answer (mailed October 16, 2007), and the Reply Brief (filed December 3, 2007) for the respective details.² We have considered in this decision only those arguments Appellants actually raised in the Briefs. Any other arguments which Appellants could have made but chose not to make in the Briefs are deemed to be waived. *See 37 C.F.R. § 41.37(c)(1)(vii).*

Appellants' Invention

Appellants' invention relates to monitoring a plurality of audio sources and allowing a user of an audio device to switch from one to another of the audio sources in response to a triggering event. (*See generally* Spec. 2:23-3:4).

Claim 41 is illustrative of the claimed invention and reads as follows:

41. A method of switching among wireless audio sources, comprising:

² The Examiner mailed a corrected Examiner's Answer on July 25, 2008, and Appellants filed a Supplemental Reply Brief on September 11, 2008. No substantive changes were made to the originally filed Answer and Reply Brief.

receiving a plurality of Bluetooth™ compliant transmissions, each including a respective input audio signal from the same network, from respective electronic devices; and

selecting at least one of said received audio signals, for output to a headset, overlaid on another audio signal in accordance with at least one stored selection instruction, said selection instruction specifying a designated triggering event for triggering said selection.

The Examiner's Rejections

The Examiner's Answer cites the following prior art references:

Wang	US 5,757,929	May 26, 1998
Lowe	US 6,298,218 B1	Oct. 2, 2001 (filed Sep. 28, 1998)
Anvekar	US 2002/0068610 A1	Jun. 6, 2002 (filed Dec. 5, 2000)

Claims 4, 5, 7-10, 13-17, 19-23, 38, 41, 42, 45, and 46 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Anvekar in view of Wang.³

Claim 50 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Anvekar in view of Wang and Lowe.⁴

³ The Examiner's Answer incorrectly lists and addresses canceled claims 1-3, 6, 11, 12, 24-37, 39, 40, 43, 44, 47, and 48. (Answer 4). The Examiner has verified that Appellants' statement of the status of the claims at page 1 of the Appeal Brief, as well as the copy of the appealed claims in the Appendix to the Appeal Brief, is correct. (Answer 3).

⁴ The Examiner's Answer incorrectly lists and addresses canceled claims 18 and 49. (Answer 12).

ANALYSIS

Claims 4, 5, 7-10, 13-17, 19-23, 38, 41, 42, 45, and 46

Appellants' arguments with respect to the obviousness rejection, based on the combination of Anvekar and Wang, of independent claims 38, 41, and 45, focus on the contention that Wang does not overcome Anvekar's deficiency in disclosing the overlaying of an audio signal on another audio signal, and the output of such overlaid signal to a headset as claimed. According to Appellants (App. Br. 5; Reply Br. 2-3), Wang discloses the outputting of an overlaid audio signal to a hands-free device on a user's garment, not to a headset as claimed. In a related argument (App. Br. 5; Reply Br. 2-3), Appellants contend that Wang actually teaches away from outputting an audio signal to a headset by calling attention to Wang's discussion of the safety risks involved in applying signals to a device, such as a headset, which blocks the user's ear (col. 1, ll. 43-55).

We do not agree with Appellants. Contrary to Appellants' arguments, we do not interpret the Examiner's position (Ans. 5, 14) as suggesting the bodily incorporation of the user's garment based audio device of Wang into the plural audio signal headset of Anvekar. Rather, it is Wang's teaching of overlaying one audio signal on another audio signal enabling a user to listen to two audio sources simultaneously that is relied upon as a rationale for the proposed combination with Anvekar. (Wang, col. 8, ll. 17-22). "The test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference . . . Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art." *See In re Keller*, 642 F.2d 413, 425 (CCPA 1981); *In re Nievelt*, 482 F.2d 965, 968 (CCPA 1973).

We further agree with the Examiner (Ans. 14) that, while Wang provides a generalized discussion of the safety disadvantages of using a headset in which a user's ears are blocked, we do not find that such a discussion amounts to a "teaching away" of using an audio mixer in a headset as argued by Appellants. As explained in *DePuy Spine, Inc. v. Medtronic Sofamor Danek, Inc.*, 567 F.3d 1314, 1327 (Fed. Cir. 2009):

"A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant." *Ricoh Co., Ltd. v. Quanta Computer Inc.*, 550 F.3d 1325, 1332 (Fed.Cir.2008) (quoting *In re Kahn*, 441 F.3d 977, 990 (Fed.Cir.2006)). A reference does not teach away, however, if it merely expresses a general preference for an alternative invention but does not "criticize, discredit, or otherwise discourage" investigation into the invention claimed. *In re Fulton*, 391 F.3d 1195, 1201 (Fed.Cir.2004).

Appellants' "teaching away" argument is unpersuasive because modifying Anvekar with the teachings of Wang in the manner proposed by the Examiner is consistent with, rather than contrary to, Anvekar's disclosure for the reasons stated by the Examiner:

For the above reasons, we sustain the Examiner's 35 U.S.C. § 103(a) rejection of independent claims 38, 41, and 45, as well as dependent claims 4, 5, 7-10, 13-17, 19-23, 42, and 46 not separately argued by Appellants.

Claim 50

We also sustain the Examiner's obviousness rejection of independent claim 50 in which the Lowe reference is applied to the combination of Anvekar and Wang to address the advertising message feature of the rejected claim. Appellants have made no separate arguments for the patentability of

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claim 50 but, instead, has relied upon arguments made with respect to independent claims 38, 41, and 45, which arguments we have found to be unpersuasive.

CONCLUSION OF LAW

Based on the analysis above, we conclude that the Examiner did not err in rejecting claims 4, 5, 7-10, 13-17, 19-23, 38, 41, 42, 45, 46, and 50 for obviousness under 35 U.S.C. § 103(a)

DECISION

We affirm the Examiner's decision rejecting claims 4, 5, 7-10, 13-17, 19-23, 38, 41, 42, 45, 46, and 50 under 35 U.S.C. § 103(a).

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv) (2010).

AFFIRMED

babc

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